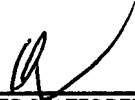




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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,811	04/19/2005	Immacolata Coraggio	GRT/3687-104	3796
23117	7590	08/23/2007		
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			EXAMINER KUMAR, VINOD	
			ART UNIT	PAPER NUMBER
			1638	
			MAIL DATE	DELIVERY MODE
			08/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/521,811

Applicant(s)

CORAGGIO ET AL.

Examiner

Vinod Kumar

Art Unit

1638

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 25 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on 25 July 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): 35 U.S.C. 112, 2<sup>nd</sup> paragraph.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: None.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 16-20 and 27-32.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
\_\_\_\_\_  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

Continuation of 11. does NOT place the application in condition for allowance because:

1. Applicant's claim amendment filed in the paper of July 25, 2007 has overcome claim rejections under 35 U.S.C. 112, 2<sup>nd</sup> paragraph related issues.

2. Newly added claims 16-20, and 27-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Osnanto et al. (Proceedings of the XLV Italian Society of Agricultural Genetics – SIGA Annual Congress Salsomaggiore Terme Italy – 26/29 September, 2001, Examiner's notice of reference cited in the paper mailed December 2, 2005), taken with the evidence of Pandolfi et al. (Plant Physiol., 114:747, 1997) and Solinas et al. (GenBank, NCBI, Sequence Accession No. Y11414, pages 1-2, Published April 1997) for the reasons of record as applied to claims 1-3, 8, and 15-26 (now cancelled) stated in the Office actions mailed on July 13, 2006, and January 25, 2007.

In the paper filed on July 25, 2007, Applicants continue to make same arguments that Office has failed to establish inherency. Applicants continue to argue that Pandolfi et al. disclose that treatments different from cold do not lead to the expression of the OsMyb4 gene. Applicants further continue to argue that newly discovered tolerances recited in the claims are surprising because it was not evident that the induction of the tolerance to cold would inherently involve the induction of tolerance to other related stresses (response, paragraph bridging pages 5 and 6; page 6, lines 19-21). Applicant's arguments were fully considered but were not found to be persuasive. It is maintained that the properties of tolerance to biotic or abiotic (salt, dehydration, oxidative or osmotic) stresses are inherent to the method of producing the transgenic plant of Osnanto et al. The method steps to produce a cold/freezing tolerant transgenic plant of Osnanto et al. are identical to instantly claimed method steps of producing a stress tolerant transgenic plant. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, rather than any distinct definition of any of the claimed invention's limitations, then preamble is not considered a limitation and is of no significance to claim construction. See MPEP 2111.02. Also see *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1346-48, 64 USPQ2d 1202, 1204-05 (Fed. Cir. 2002) where a claim at issue was directed to a method of preparing a food rich in glucosinolates wherein cruciferous sprouts are harvested prior to the 2-leaf stage. The court held that the preamble phrase "rich in glucosinolates" helps define the claimed invention, as evidenced by the specification and prosecution history, and thus is a limitation of the claim (although the claim was anticipated by prior art that produced sprouts inherently "rich in glucosinolates"). Furthermore, see *Integra LifeSciences I Ltd. v. Merck KGaA* 50 USPQ2d 1846, 1850 (DC Calif 1999), which teaches that where the prior art teaches all of the required steps to practice the claimed method and no additional manipulation is required to produce the claimed result, then prior art anticipates the claimed invention. Furthermore, it is important to note the Pandolfi et al. does not indicate or suggest that over-expression of OsMyb4 gene in a transgenic plant would not produce tolerance to salt, dehydration or anoxia. It is also important to note the difference between an endogenous expression of OsMyb4 gene (Pandolfi et al. teachings, emphasis added) under salt, dehydration or anoxia stresses versus the over-expression of OsMyb4 gene in a transgenic plant (Osnanto et al. teachings, emphasis added). The expression of endogenous OsMyb4 gene in response to salt, dehydration or anoxia stress is regulated by its native promoter, whereas, the transgenic plants would constitutively express OsMyb4 gene product to impart tolerance to instantly claimed stresses because said tolerance to biotic or abiotic stresses is an inherently associated property of SEQ ID NO: 1 (OsMyb4 gene) encoding SEQ ID NO: 2. Furthermore, it is maintained that low temperature/freezing tolerance is also a measure of dehydration tolerance. It may be emphasized that said inherent properties of instant SEQ ID NO: 1 encoding OsMyb4 (SEQ ID NO: 2) are further evidenced by Immacolata et al. (US Patent Publication No. 2050204431, Published September 15, 2005). Accordingly, the rejection is maintained.

3. Claim amendment filed in the paper of July 25, 2007 has overcome 35 U.S.C. 102(b) rejection as being anticipated by Alexandrov et al. (EP 1033405 A2, Published June 9, 2000).

4. Claim amendment filed in the paper of July 25, 2007 has overcome 35 U.S.C. 102(e) rejection as being anticipated by Cahoon et al. (US Patent Publication No. 20020066120, Filed November 19, 1999).

5. Claims 29-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 29 recites "tolerant to at least the biotic, salt-induced, dehydration-induced, oxidative, and osmotic stresses" which introduces NEW MATTER into the claim. The specification does not provide written description support for any stress tolerant properties (other than salt, dehydration, biotic, oxidative or osmotic stresses) of SEQ ID NO: 1 encoding SEQ ID NO: 2. This does not comply with written description requirements. Claim 30 recites "selecting a plant for lack of tolerance to a biotic, salt-induced, dehydration-induced, oxidative, or osmotic stresses" which introduces new matter into the claim. The specification does not provide written description support for selecting a plant for lack of tolerance to a biotic, salt-induced, dehydration-induced, oxidative, or osmotic stress, and then transforming said plant with a nucleotide sequence encoding instant SEQ ID NO: 2. This does not comply with written description requirements. Claims 31-32 are also rejected because they fail to overcome the deficiency of claim 30.

DAVID H. KRUSE, PH.D.  
PRIMARY EXAMINER

